

REMARKS

This paper is in response to the Final Office Action mailed August 9, 2007. In the Office Action, the Examiner rejected claims 1, 4, 5, 8-13, 16, 17, 20-25, 28, 29, 32-36, and 44-52 under 35 U.S.C. § 103. No claims have been amended, added, or cancelled. Thus claims 1, 4, 5, 8-13, 16, 17, 20-25, 28, 29, 32-36, and 44-52 remain pending. Reconsideration in light of the remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1, 4-5, 8-11, 13, 16-17, 20-23, 25, 28-29, 32-35 and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Schena, et al. (U.S. Patent No. 6,448,979) in view of Robinson, et al., "The Origami Project: Paper Interfaces to the World-Wide Web," and further in view of Gormish et al. (U.S. Patent No. 5,337,362). Applicants respectfully disagree.

Schena describes a system in which a bar code is read from a printed medium (Schena, column 1, line 61 to column 2, line 25). The bar code contains link information to corresponding multimedia sequence information, such as advertising, transaction information, text information, etc. (Schena, column 2, lines 13-25; column 3, line 58 to column 4, line 5). A scanner that detects the barcode routes the link information to a server, which selects information corresponding to the received link (Schena, column 2, lines 29-54).

Robinson describes a system for creating a "digital desk" that represents a real-world desk (Robinson, page 1). Document such as web pages printed on paper may be placed on a physical desk and animated in the digital desk (Robinson, page 2). Thus, when a user selects a link on a paper web page, the digital desk follows the link to the destination web page (Robinson, pages 2 and 4-5).

Gormish describes placing digital data on paper (Gormish, Abstract). A bar code is generated to represent digital data that may be transferred to and from plain paper (Gormish, column 2, lines 8-41; Figures 1 and 4).

Claim 1 recites:

A method comprising:
creating a multimedia annotation for a paper document, the multimedia annotation representing at least one of an audio sound and a video clip; and
creating a first multimedia document by combining the paper document and the multimedia annotation represented by a first bar code encoding the at least one of the audio sound and video clip,
wherein the first multimedia document is generated as a part of reproducing the paper document via a document reproduction system, wherein the multimedia annotation is captured via an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system. wherein the captured multimedia annotation is encoded within the first bar code, and
wherein the first multimedia document, which when scanned by a process, the process causes the printed multimedia annotation to be decoded, the at least one of the audio sound and video clip to be extracted from the multimedia annotation, and the at least one extracted audio sound and video clip can be played via a multimedia player.

That is, claim 1 includes encoding at least one of an audio and video clip, captured via an input device of a document reproduction system, in a bar code. The bar code can be printed on a multimedia document, when the multimedia document is generated by the document reproduction system, such as a scanner or copier. The multimedia document includes the bar code encoding the audio sound and/or video clip which can be subsequently scanned and decoded to extract the audio sound and/or video clip. The extracted audio sound and video clip can then be played by a multimedia player.

Schena describes following a scanned link to obtain content from a server (Schena, column 2, lines 29-54). Robinson animates link selection on a physical paper in a digital environment by following a selected link at a digital desk (Robinson, pages 2 and 4-5). Gormish

encodes digital data into a barcode (Gormish, Abstract). None of the references, however, are directed towards encoding a sound or video clip in a barcode, such that the barcode can be decoded, the sound or video clip extracted from the decoded barcode, and played via a multimedia player, as claimed in claim 1. Although the references describe encoding static digital data and links, which may be traversed to obtain content indicated by the link, none of the references provide for encoding multimedia data, such as voice and sound clips, directly in a barcode.

The Examiner states that the claim language, when interpreted in light of the Applicants' specification, is interpreted as an annotation being a link (Final Office Action, mailed August 9, 2007, pages 26-27). The Examiner is correct in noting that the Applicants specification does state that an annotation may take many forms, such as encoding multimedia content or indicating a link to a multimedia content (*See* Specification, discussion accompanying figure 1). However, Applicants claim recites:

creating a first multimedia document by combining the paper document and the multimedia annotation represented by a first bar code encoding the at least one of the audio sound and video clip,

wherein the first multimedia document is generated as a part of reproducing the paper document via a document reproduction system, wherein the multimedia annotation is captured via an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system, wherein the captured multimedia annotation is encoded within the first bar code ...

(Emphasis Added)

Thus, applicants claim language recites limitations directed at a barcode that directly *encodes* the multimedia content, and not a barcode that represents a link to the multimedia content. Although annotations may represent links to multimedia content, this is not what is claimed by Applicants.

Because “limitations appearing in the specification but not recited in the claim should not be read into the claim” (MPEP 2106.II.C *citing E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily)), Applicants respectfully submit that the Examiner is interpreting the claims beyond that which would be understood by one of ordinary skill in the art.

The link described by Schena only provides a pointer or location where the encoded annotation may be obtained. The link, itself, however cannot be decoded and played as a voice or video clip in a media player. Furthermore, this concept is wholly absent from Robinson as well as Gormish.

Furthermore, the Examiner states that Schena and Robinson fail to teach or suggest:

wherein the multimedia annotation is captured via an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system, wherein the captured multimedia annotation is encoded within the first bar code.

The Examiner utilizes Gormish to supply the limitation, stating that Gormish describes “a reproduction system” that outputs encrypted data as a bar code on plain paper (Final Office Action, page 9). As described in Gormish, scan, ASCII, or binary image data is captured, encoded, and printed as pixels on a paper (*See Gormish, Figure 1*). Furthermore, the pixels may be printed in several boxes on the paper (Gormish, column 4, lines 3-17). The scan, ASCII, or binary image data, however, is never described as being captured “while the paper document is being reproduced via the document reproduction system.”

Therefore, Schena, Robinson, and Gormish, alone or in combination, fail to render claim 1 obvious for at least the reasons set forth above. Because claims 13 and 25 include limitations

similar to those discussed above with respect to claim 1, claims 13 and 25 are similarly not anticipated by Schena, Robinson, and Gormish. Given the remaining claims depend from one of the above independent claims, for reasons similar to those set forth above, it is respectfully submitted that the rest of the claims are also patentable over Schena, Robinson, and Gormish.

In view of the above, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 4-5, 8-11, 13, 16-17, 20-23, 25, 28-29, 32-35 and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Schena, in view of Robinson, and further in view of Gormish.

With respect to claim 11, the present invention as claimed requires that a second multimedia document be automatically sent, to a recipient specified by a user of the document reproduction system, as part of reproducing the paper document at the document reproduction system. Applicants respectfully submit that the limitation is not shown or suggested by any of Schena, Robinson, or Gormish. The Examiner cites column 4, line 35 of Schena and states that Schena discloses link information that is published or located, along with message specific information, in a machine-readable code. Applicants respectfully disagree. Schena merely provides for a code that may indicate a specific advertisement, the web address of a particular advertiser, date/content of an advertisement, etc. (*See e.g.*, Schena, column 4, lines 7-31). Thus, after a barcode is scanned, a user may be provided with a specific advertisement. The concept of automatically sending a multimedia document as part of reproducing a paper document and that the recipient is specified by a user of the document reproduction system when the user reproduces the document, is absent from Schena. Furthermore, Robinson and Gormish also fail to provide for the above limitation. In view of this, Applicants submit that claim 11, and similarly claims 23 and 35, are not rendered obvious by Schena, Robinson, and Gormish.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 4-5, 8-11, 13, 16-17, 20-23, 25, 28-29, 32-35 and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Schena, in view of Robinson, and further in view of Gormish.

Claims 12, 24, and 36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Schena, in view of Robinson, further in view of Halliday, and further in view of Halliday et al. (U.S. Patent 5,880,740). Applicants respectfully disagree.


Claims 12, 24, and 36 depend from one of the above independent claims. It is respectfully submitted that Halliday also fails to disclose the limitations set forth above. Therefore, for reasons similar to those set forth above, it is respectfully submitted that claims 12, 24, and 36 are also patentable over Schena and Robinson. Withdrawal of the rejections is respectfully requested.

Conclusion

Applicant reserves all rights with respect to the applicability of the doctrine of equivalents. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
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